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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,368	12/21/2001	Catherine C. Thompson	P 0283266	3991
909	7590	10/28/2004	EXAMINER	
PILLSBURY WINTHROP, LLP P.O. BOX 10500 MCLEAN, VA 22102			CARLSON, KAREN C	
			ART UNIT	PAPER NUMBER
			1653	

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/024,368

Applicant(s)

THOMPSON, CATHERINE C.

Examiner

Karen Cochran Carlson, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on August 26, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,20,22,25-28,30,31,33 and 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,20,22,25-28,30,31,33 and 34 is/are rejected.
- 7) ☒ Claim(s) 2 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

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This Office Action is in response to the paper filed on August 26, 2004. Claims 3, 9-19, 21, 23, 24, 29 and 32 have been canceled. Claims 1, 2, 4-8, 20, 22, 25-28, 30, 31, 33, and 34 are currently under examination.

Priority is to April 7, 1998.

Withdrawal of Objections and Rejections

The rejection of Claims 22, 24, 28, 30, 31, and 33 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-19 of U.S. Patent No. 6,348,348 is withdrawn.

The rejection of Claims 1-9, 20-22, 24-28, 30, 31, and 33 under 35 U.S.C. 112, second paragraph, as set forth in the previous Office Action, is withdrawn.

Upon review of the Declaration of Catherine Thompson, the following rejections are withdrawn:

The rejection of Claims 1-4, 6, 7, 9 and 21 under 35 U.S.C. 102(a) as being anticipated by Ahmad et al. (Jan. 30, 1998; Science 279:720-724) is withdrawn.

The rejection of Claims 1, 2, and under 35 U.S.C. 102(b) as being anticipated by Cachon-Gonzalez et al. (1994; PNAS 91:7717-7721) is withdrawn.

The rejection of Claims 1-9 and 21 under 35 U.S.C. 102(b) as being anticipated by Thompson (Dec. 15, 1996; J. Neurosci. 16(24): 7832-7840) or under 35 U.S.C. 102(c) because the invention has been abandoned is withdrawn.

Maintenance of Objections and Rejections

The disclosure is again objected to because of the following informalities: The application cross reference at page 1 must be updated to reflect that '354 is now a patent.

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Appropriate correction is required.

Applicants have not commented on this issue in their response.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 4, 6, 7, 20, 22, 25-28, 30, 31, 33, and 34 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not teach variants of SEQ ID NO: 2 having activity. Therefore, the specification lacks written description of variants of SEQ ID NO: 2.

Applicants may overcome this rejection by amending claim 1 with the limitations of Claim 2, for example, "wherein the polypeptide has hairless transcription factor activity".

Applicants urge that the specification teaches variants of SEQ ID NO: 2 having activity. Applicants are referred to the Written Description Guidelines, and specifically to Example 14 wherein the structure of variants of polypeptides (having known function) and function will be set forth in the claims. One skilled in the art should know when they have arrived at Applicants polypeptide because if, for example, another has a polypeptide that comprises at least 75 amino acids of SEQ ID NO: 2 then they can perform an assay for hairless transcription activity and determine if their polypeptide infringes Applicants polypeptide.

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New Rejections

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4, 6, 7, 20, 22, 25-28, 30, 31, 33, and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claims 1 and 34 the term "identical" is used to describe molecules having "98% identical to SEQ ID NO: 1". The term "identical" is an absolute term, meaning, one thing is either identical to another thing or it is not. Applicants may wish to amend the claims to recite -- identity --.

In Claims 1(d) and 34(c), the polypeptide is stated to be encoded by "a nucleotide sequence complementary to the nucleotide sequence of (a) or (b) or (c)". The complementary DNA is the antisense or non-coding strand of DNA. Therefore, it is not clear how the non-coding strand of a nucleic acid molecule can encode a polypeptide.

Claims 2 and 8 are objected to for being dependent on a rejected base claim.

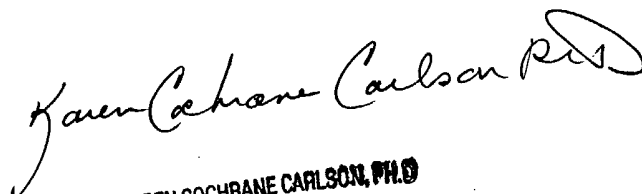
No Claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Cochrane Carlson, Ph.D. whose telephone number is 571-272-0946. The examiner can normally be reached on 7:00 AM - 4:00 PM, off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


KAREN COCHRANE CARLSON, PH.D.
PRIMARY EXAMINER